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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/900,360	07/25/1997	WELLS OBRECHT	2569-0103P	8032
2292	7590	12/05/2003	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/900,360

Applicant(s)

OBRECHT, WELLS

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. In response to the Board Decision rendered September 25, 2003, prosecution of the instant application is being reopened.

Claims 1-20 are presented for examination.

Claim Objections

2. Claims 15 and 19 are objected to because of the following informalities:

Claim 15, line 2, delete "including", insert --includes--

Claim 19, line 3, delete "mans", insert --means--

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 and 2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to

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promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claim 1 recites the useful, concrete, and tangible application of ranking sellers and providing this information to a buyer; however, claim 1 is not limited to the technological arts. In other words, all of the recited steps could be performed manually by a human and therefore do not necessarily apply, involve, use, or advance the technological arts. Further, mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. In claim 2, the receipt of a request by a computer is deemed to be a nominal use of a hardware component. Claim 2 still fails to apply, involve, use, or advance the technological arts. Therefore, claims 1 and 2 are found to be non-statutory for failure to be limited to the technological arts.

Please note that claim 3 is deemed to be statutory because it is expressly recited that a central computer is performing one of the core steps of the invention, i.e., selecting at least one seller from a predetermined group of sellers of goods or services based on the received predetermined plurality of criteria.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-9, 17, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In step (c) of claim 1, it is recited that the request of the buyer is transmitted to "at least one seller of the goods or services." However, step (f) of claim 1 recites the ranking of "the sellers." The phrase "at least one" implies one or more. In the case of a request being submitted to only one seller, it is not clear how a ranking *per se* can be accomplished. Furthermore, this issue is indicative of an antecedent basis problem with "the sellers" in step (f) if only one seller is selected in step (b).

Claims 2-9 are dependent from claim 1 and therefore inherit the same rejections under 35 U.S.C. § 112, 2nd paragraph.

It is not clear whether the limitation "vehicle computers or appliances" (in line 2 of claim 17) should read as "vehicle computers" (i.e., computers associated with a vehicle) or "appliances" or if it should be read as "vehicles, computers, or appliances." For examination purposes, "vehicle computers or appliances" will be interpreted as "vehicles, computers, or appliances."

Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over CarBargains, as disclosed in the following references:

McKenzie ("Car Sales Firm Represents Buyers Looking for a Good Deal");

Barciela ("Need a Car But Hate to Haggle? Service Will Negotiate for You");

PR Newswire ("Southern California Gets New Service That Makes Car Dealers Bid for Customers' Business"); and

Laugesen ("Here's a New Way of Buying a Car")

in view of Interax, as disclosed in the article, "Honestly the Best Policy."

CarBargains discloses a method for purchasing goods or services from a seller by a buyer comprising:

[Claim 1] (a) receiving a request from a buyer for goods or services with a predetermined plurality of criteria related to the goods or services (McKenzie: ¶ 4; Barciela: ¶ 6);

(b) selecting at least one seller from a predetermined group of sellers of the goods or services based on the received predetermined plurality of criteria (McKenzie: ¶¶ 5-6 -- CarBargains calls at least five car dealers, who then submit bids through CarBargains. Presumably, CarBargains is contacting dealerships who they know at least sell the desired make of car, e.g., Lexus, Honda, etc.);

(c) transmitting the request of the buyer to the selected at least one seller of the goods or services (McKenzie: ¶ 5; Barciela: ¶ 7);

(d) receiving, within a predetermined time interval, responses from the at least one seller to the request (McKenzie: ¶ 5; Laugesen: ¶ 37 -- Responses are received within two weeks);

(e) compiling information provided in the responses received from at least one seller within the predetermined time interval (McKenzie: ¶¶ 5-7; Laugesen: ¶ 37 -- Responses are received and compiled to be given to the buyer within two weeks);

(g) providing the compiled responses of the selected seller for access by the buyer (McKenzie: ¶¶ 5-7).

Regarding claim 1, CarBargains provides buyers with lists of quotes from various car dealers; however, CarBargains leaves the comparison of the car dealers and their respective offers up to the buyer. In other words, CarBargains does not expressly teach a ranking of the sellers based upon the compiled information including the plurality of criteria and selecting sellers with the relatively highest ranking. Interax makes up for this deficiency in its teaching of an on-line quotation system "which captured a customer's individual requirements and provided a list of insurance companies instead of simply obtaining one quote at a time. The list was ranked in order, not just by cost but also by projected bonuses and past performance as well" ("Honestly the Best Policy": page 33, column 2). The provision of an automatically generated list of ranked insurance companies facilitates the quick and confident selection of an insurance

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company that best meets a customer's needs, thereby implying that it is desirable for a customer to select an insurance company with the relatively highest ranking since such an insurance company would likely best fit the customer's needs. Both CarBargains and Interax provide brokerage services for assisting customers in easily locating vendors who best meet the customers' needs regarding desired products or services; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement with CarBargains' service the step of "(f) ranking the sellers based upon the compiled information including the plurality of criteria and selecting sellers with the relatively highest ranking" in order to facilitate the quick and confident selection of a car dealership whose offer best meets the car buyer's needs, thereby implying that it is desirable for the buyer to select a car dealership with the relatively highest ranking since such a dealership would likely best fit the buyer's car and financial needs.

[Claims 2, 3] As per claims 2 and 3, CarBargains' requests are made over the telephone; CarBargains fails to expressly teach the receipt of a request via a computer or the selection of at least one seller via a central computer. However, Interax discloses that its "[i]nsurance quotations could be obtained on-line through a Prestel gateway from software run by the insurance companies themselves" ("Honestly the Best Policy": page 33, column 1). Further, "Interax acts as an electronic librarian, ensuring that comparative information is presented to the broker so he can offer his customer the best advice" ("Honestly the Best Policy": page 33, caption under picture at top of page). The

conversion of this insurance comparison process from a manual process to a computerized one addresses the problem that “as the number of such ‘electronic ratebooks’ increases the comparison process becomes complex and very time-consuming. What is required is the electronic equivalent of a librarian to ‘open the books at the right page’ to ensure that comparative information is presented to the broker in a logical and meaningful manner.” (“Honestly the Best Policy”: page 33, column 1) In other words, it is old and well-known that the automation of a manual process typically promotes more accurate and rapid processing of large amounts of data. Therefore, the Examiner asserts that it would have obvious to one of ordinary skill in the art at the time of Applicant’s invention to implement CarBargain’s step of receiving a request from a buyer via a computer and the step of selecting at least one seller using a central computer in order to promote more accurate and rapid processing of large amounts of data, thereby enhancing CarBargain’s ability to handle an increased volume of requests for car quotes from its customers.

9. Claims 4-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over CarBargains, as disclosed in the following references:

McKenzie (“Car Sales Firm Represents Buyers Looking for a Good Deal”);
Barciela (“Need a Car But Hate to Haggle? Service Will Negotiate for You”);
PR Newswire (“Southern California Gets New Service That Makes Car Dealers Bid for Customers’ Business”); and
Laugesen (“Here’s a New Way of Buying a Car”)

in view of Interax, as disclosed in the article, "Honestly the Best Policy," as applied to claim 3 above, and *further in view of* Reilly ("Firms Join Virtual Marketplace").

[Claims 4, 7] Regarding claims 4 and 7, neither CarBargains nor Interax explicitly teaches the use of the Internet to transmit the request of the buyer to the at least one seller or to allow the buyer to access the compiled responses of selected sellers. However, Reilly makes up for this deficiency in his discussion on how the Internet is used for various business activities, including comparing prices and accepting bids in a marketplace (§ 4). The Internet provides a relatively inexpensive forum where businesses can "advertise to a global market" (§ 13), thereby expanding a business' customer base and potential for income/profit. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt CarBargains' service to be accessible over the Internet such that the Internet is used to transmit the request of the buyer to the at least one seller or to allow the buyer to access the compiled responses of selected sellers in order to provide a relatively inexpensive forum where CarBargains can "advertise to a global market" (Reilly: § 13), thereby expanding its customer base and potential for income.

[Claims 5, 6] As per claims 5 and 6, CarBargains' receipt of responses from at least one seller and compiling of information provided in the responses are made over the telephone and/or by hand; CarBargains fails to expressly teach that the receipt of responses from at least one seller, the compiling of information provided in the

responses, and the ranking of sellers are performed by a central computer. However, Interax discloses that its “[i]nsurance quotations could be obtained on-line through a Prestel gateway from software run by the insurance companies themselves” (“Honestly the Best Policy”: page 33, column 1). Further, “Interax acts as an electronic librarian, ensuring that comparative information is presented to the broker so he can offer his customer the best advice” (“Honestly the Best Policy”: page 33, caption under picture at top of page). The conversion of this insurance comparison process from a manual process to a computerized one addresses the problem that “as the number of such ‘electronic ratebooks’ increases the comparison process becomes complex and very time-consuming. What is required is the electronic equivalent of a librarian to ‘open the books at the right page’ to ensure that comparative information is presented to the broker in a logical and meaningful manner.” (“Honestly the Best Policy”: page 33, column 1) In other words, it is old and well-known that the automation of a manual process typically promotes more accurate and rapid processing of large amounts of data. Therefore, the Examiner asserts that it would have obvious to one of ordinary skill in the art at the time of Applicant’s invention to implement CarBargain’s steps of receiving responses from the at least one seller to the request, compiling information provided in the responses received from at least one seller within the predetermined time interval, and ranking the sellers based upon the compiled information by a central computer in order to promote more accurate and rapid processing of large amounts of data, thereby enhancing CarBargain’s ability to handle an increased volume of requests for car quotes from its customers.

CarBargains discloses a method for purchasing goods or services from a seller by a buyer:

[Claim 8] wherein the goods are selected from the group consisting of vehicles, computers, or appliances and the services are selected from the groups consisting of legal, financing, medical, or insurance (McKenzie: ¶ 4);

[Claim 9] wherein the goods are vehicles (McKenzie: ¶ 4).

[Claims 10-18] Claims 10-18 recite limitations already addressed by the rejection of claims 1-9 above; therefore the same rejection applies. Furthermore, it should be noted that CarBargains teaches the selection of at least two providers (instead of “at least one”). CarBargains contacts “at least five dealers in the local area” (McKenzie: ¶ 5), thereby addressing this limitation.

[Claims 19-20] Claims 19-20 recite limitations already addressed by the rejection of claims 1-9 above; therefore the same rejection applies. Furthermore, it should be noted that CarBargains teaches the selection of at least two providers (instead of “at least one”). CarBargains contacts “at least five dealers in the local area” (McKenzie: ¶ 5), thereby addressing this limitation.

As per claim 20, CarBargains is used to locate cars of interest for a buyer; however, it does not expressly state that a buyer requests a previously owned automobile *per se*. This difference is only found in the non-functional descriptive material and is not functionally involved in the steps recited nor does it alter the recited structural elements. The recited method steps would be performed the same

regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106. Furthermore, Official Notice is taken that the sale of previously owned automobiles is old and well-known in the art of automobile sales. By selling both new and previously owned automobiles, a dealer or automobile broker expands his/her customer base, thereby increasing one's likelihood of generating income/profit. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt CarBargains to find both new and previously owned automobiles for its buyers in order to expand its customer base, thereby increasing the likelihood of generating income.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

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Any response to this action should be mailed to:

**Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.

Susanna Diaz

Susanna M. Diaz
Primary Examiner
Art Unit 3623
November 13, 2003


**JOHN J. LOVE
DIRECTOR
TECHNOLOGY CENTER 3600**